

Application No. 10/734,501
Filing Date 12/12/2003

Docket JP920030154US1

REMARKS

Posture of the case

Claims 1-38 were originally filed. The present Office action of March 16, 2007, is a first Office action. Claims are herein amended and canceled, and new claims are herein presented, as set out above.

Prior art rejections

Claims 1-8, and 13-15, 21, 24, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Nachenberg (US 6,021,510). Applicant respectfully traverses the rejection at least with regard to claims 5 and 13. To overcome the rejection, Applicant herein submits an amendment to claim 1 incorporating the language of claim 5, and cancels claim 5. (However, the language from claim 5 is slightly reworded to make the amended claim more clear.) Applicant also herein cancels claims 15-38 and submits new claims 39-63 setting out claims similar to method claims 1-4 and 6-14, but according to respective computer program product and computer system forms of the invention.

Claims 1, 39 and 52

In particular, claim 1 is amended to state that the recited step of computing a new set of hash values includes "reading the set of resources from a first storage medium of a system in the data processing network into a second storage medium of the system, the second storage medium providing faster access than the first storage medium, wherein the computing of the new set of hash values accesses the set of resources read to the second storage medium." This slight change in wording relative to original claim 5 is submitted in order to make all the more certain that claim 5 is not construed as reciting redundant language regarding computing, and to make it all the more clear how the computing of the new set of hash values relates to the reading of the resources from the second storage medium.

Also, claim 1, as amended, states that the method further includes "comparing each resource of the set of resources with a maximum size limit to identify a subset of the resources, wherein each resource of the subset is smaller than said size limit." This slight change in wording relative to original claim 5 is submitted in order to emphasize that

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each resource of the identified subset of resources that are read into is smaller than a size limit.

Also, claim 1, as amended, states that "said subset of resources [is retained] within said second storage medium," as original claim 5 stated.

Also, claim 1, as amended, states that the method includes "performing, for the subset of resources retained within said second storage medium, further operations on ones of the subset of resources." This slight change in wording relative to original claim 5 sets out the recited feature as an affirmative step, to emphasize the weight that should be given to the recited feature. It also emphasizes that all the resources of the subset are retained in the second storage medium for the further operations.

Finally, the amended claim also states that the further operations are selected from operations including "making backup copies and transferring copies of the resources of the subset of resources to other systems," which is more specific than what was originally recited in claim 5.

No new matter is added, since the original application provides support for the amendment to claim 1. See original published application, claim 5 and paragraph 84.

The Office action asserts that comparing each of the set of resources with a maximum size limit to identify resources within said set which are smaller than the size limit is inherent in what is taught by Nachenberg, since it is a common feature of memory management that data does not exceed a storage threshold. The Office action further asserts that retaining smaller resources within a second storage medium to enable further operations is known, since it is inherent to hold only an amount that is available in the second storage. In this connection, the Office action points out that Nachenberg teaches the use of sectors (column 3 line 66 to column 4 line 10), which are fractions of the original file.

Applicant respectfully submits that amended claim 1 is patentably distinct. The claim, as amended, states that the *subset of resources* is retained within said second storage medium and that *each resource* of the subset is smaller than the size limit. Thus, it is clear that the well known fact cited by the Office action about a storage medium having a maximum capacity does not inherently teach what is claimed. This well known

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fact *does* establish that a storage medium cannot hold more than its capacity. But neither this, nor the teaching by Nachenburg about sectors, teaches or suggests “comparing each resource of the set of resources with a maximum size limit to identify a subset of the resources, wherein each resource of the subset is smaller than said size limit” and “retaining said subset of resources within said second storage medium,” as now claimed.

Further, Nachenburg does not teach or suggest “performing, for the subset of resources retained within said second storage medium, further operations on ones of the subset of resources.” The Office action *does not even explicitly assert* that Nachenburg teaches, or at least does not cite any specific portion of Nachenburg that teaches or suggests, or any inherent feature of the teaching of Nachenburg that at least suggests, the originally claimed feature of claim 5 in this regard, i.e., “retaining . . . resources within said second storage medium to enable further operations,” which occurs in combination with the operations recited earlier in claim 1. All the more certainly, the cited art does not teach or suggest that the further operations are selected from operations including “making backup copies and transferring copies of the resources of the subset of resources to other systems,” as now claimed.

Applicant submits claims 39 and 52 are allowable for similar reasons. No new matter is added by new claims 39 and 52, since the original specification provides support for the claims. See above remarks and original claims 1-38. See also, original FIG. 1 and published application paragraphs 39-44.

Claims 13, 50 and 63

The Office action asserts that because Nachenberg, column 3, lines 14-15, discloses the use of Norton Antivirus and because, the Office action asserts, *Norton Antivirus Enterprise Solution 4.0* has a capability for “scanning compressed files,” and asserts that Nachenberg, therefore, at least inherently discloses at least one resource of the set of resources comprises a group of files and that a single hash value is computed for the group of files.

Applicant respectfully disagrees. “Scanning compressed files” is not the same as, nor does it suggest, what is recited in claim 13, namely, “computing a single hash value for a group of files,” for at least two reasons. First, scanning is not the same as

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computing a hash. Second, even if scanning were the same as computing a hash, the statement "scanning compressed files" does not even necessarily mean scanning a number of files in a single scan. For these reasons, the rejection is improper.

In addition, the rejection would be improper even if scanning compressed files were the same as computing a single hash value for a group of files, because the Office action relies upon a presumed feature of *Norton Antivirus Enterprise Solution 4.0*, but has not established any basis for propounding *Norton Antivirus Enterprise Solution 4.0* as prior art. Indeed, the Office action has not explicitly asserted that *Norton Antivirus Enterprise Solution 4.0* is prior art. Further, and importantly, the Office action has not provided any document that demonstrates the asserted teaching of *Norton Antivirus Enterprise Solution 4.0*. For at least these additional reasons, the rejection is improper.

Applicant submits claims 50 and 63 are allowable for similar reasons. No new matter is added by new claims 50 and 63, since the original specification provides support for the claims. See above remarks and original claim 13. See also, original FIG. 1 and published application paragraphs 39-44.

Claims 2-4, 6-12 and 14, 40-49, 51 and 53-62

Applicant submits that dependent claims 2-4, 6-12 and 14, 40-49, 51 and 53-62 are allowable at least because they depend on respectively allowable claims. No new matter is added by new claims 40-49, 51 and 53-62, since the original specification provides support for the claims. See above remarks and original claims 1-38. See also, original FIG. 1 and published application paragraphs 39-44.

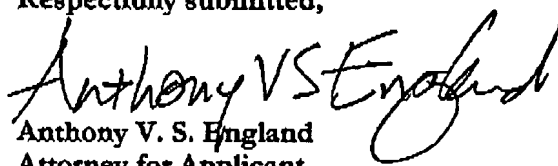
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REQUESTED ACTION

Applicant contends that the invention as claimed in accordance with amendments submitted herein is patentably distinct, and hereby requests that Examiner grant allowance and prompt passage of the application to issuance.

Respectfully submitted,



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